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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,811	06/11/2007	Kristin Hoyne Gomes	2348.0130001	3994
53636 7590 06/25/2009 STERNE, KESSLER, GOLDSTEIN & FOX, P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005-3934				
EXAMINER CHENCINSKI, SIEGFRIED E				
ART UNIT 3695		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/588,811

**Applicant(s)**

GOMES ET AL.

**Examiner**

SIEGFRIED E. CHENCINSKI

**Art Unit**

3695

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date 8/09/06
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

#### 1. OBJECTION

##### **No Abstract has been received with this application.**

The abstract of the disclosure is objected to because it exceeds the maximum permitted length of 150 word, and because it contains references to the drawings which obscure the purpose of the Abstract. Correction is required. See MPEP § 608.01(b), which is duplicated here for Applicant's convenience:

(b) A brief abstract of the technical disclosure in the specification must commence on a separate sheet, preferably following the claims, under the heading "Abstract" or "Abstract of the Disclosure." The sheet or sheets presenting the abstract may not include other parts of the application or other material. The abstract in an application filed under 35 U.S.C. 111 may not exceed 150 words in length. The purpose of the abstract is to enable the United States Patent and Trademark Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure.<

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;

- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

**Applicant is requested to submit an Abstract which comply with the spirit and letter of the above guidelines with Applicant's response to this Office Action.**

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**1. Claims 1-25 are rejected** because the claimed invention is directed to non-statutory subject matter. Independent claims 1, 16, 24 and 25 recite a process comprising receiving, processing, transmitting, determining, combining and generating. Dependent claims 2-15 and 17-23 are rejected because of their dependence on independent claims 1 and 16. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. Without these elements the invention involves human interaction which is not patentable subject matter. In Applicant's independent claims a human interaction is clearly possible, even in claim 16, where the party doing the transmitting and the receiving can clearly be a human.

The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See Benson, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, as illustrated by Benson and discussed below, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See Benson, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-resolution activity. See Flook, 437 U.S. at 590. (*In re Bilski*, En banc, U.S. Court of Appeals for the Federal Circuit, Washington, DC, Oct. 30, 2008). Per *In re Bilski*, these requirements must be present in each meaningful limitation step and must not merely rely on such limitations in the preamble. Applicant is advised to avoid new matter in complying with these requirements, and to refer to the locations of support in the specification when making such amendments.

**2. Claims 1-15 and 25 are rejected** because the claimed inventions of claims 1 and 25 have an inactive and inconclusive end. The last step of processing leads to an unknown end and does not fulfill the purpose stated in the preamble. The claimed invention therefore has no patentable utility and lacks concreteness and tangibility. No transformation has occurred.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**3. Claims 1-15 and 25 are rejected** under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the invention. Independent claims 1 and 25 have an inconclusive end, thus preventing an ordinary practitioner from using the invention without unreasonable experimentation.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**4. Claims 1-15 and 25 are rejected under 35 U.S.C. 112, second paragraph,** as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Independent claims 1 and 25 have an inconclusive end, thus preventing an ordinary practitioner from using the invention without unreasonable experimentation.

#### **Amendments**

**5.** Applicant is advised to refer to the disclosure for support in making amendments in response to this office action.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere & Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**6. Claims 1-25 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Basch et al. (US Patent 6,658,393 B1, hereafter Basch) in view of Lawrence (US PreGrant Publication 2003/0225687 A1).

**Re. Claim 1**, Basch discloses a method for predicting financial risk is disclosed. The method includes receiving data inputs on a first computing system. The data inputs includes historical data associated with at least a first account issued to an account owner, and the historical data includes historical transaction information for the first account. The method also includes generating a predictive model based on at least the historical data, receiving a current transaction authorization request associated with the first account on the first computing system, and generating a risk score by applying the predictive model to data associated with the current transaction authorization request. The current transaction authorization request is denied when the risk score indicates an unacceptable level of risk. In one embodiment, the data inputs further include performance data that is at least partially indicative of past fraudulent activities associated with the first account and at least one other account held by the account owner. (Abstract).

Basch discloses a method for authorizing a financial transaction between a merchant and an account holder of a financial account, comprising:

- receiving, from the merchant for use in real-time authorization, transaction variables for a transaction using the financial account, (Col. 3, ll. 53-64); and
- processing the transaction variables through a fraud-risk model to determine a risk factor for the transaction (Col. 11, ll. 47-65)..

Bausch does not explicitly disclose a transaction involving a purchase of a travel ticket, the transaction variables including a passenger name on the travel ticket, a travel date, a routing description of the travel ticket, and an electronic ticket indicator. However, the examiner gives Official Notice that a transaction involving a purchase of a travel ticket,

the transaction variables including a passenger name on the travel ticket, a travel date, a routing description of the travel ticket, and an electronic ticket indicator was well known at the time of Applicant's invention since thousands of such transactions were being made daily through travel agencies and airlines at that time. Further, Lawrence discloses a travel related risk management clearinghouse associated with travel arrangements ([0007], [0008], and 0011)-II. 1-3. Therefore, the ordinary practitioner of the art at the time of Applicant's invention would have seen it as obvious to have combined the disclosures of Basch, Lawrence, Official Notice and the practitioner's own knowledge in order to produce a method for authorizing a financial transaction between a merchant and an account holder of a financial account, motivated by a desire to provide methods and systems which will utilize information to assist with risk management and due diligence related to travel arrangements (Lawrence, page 1, [0006]).

**Re. Claim 16**, the disclosures of Basch, Lawrence and Official Notice are stated in the rejection of claim 1 above. None of Basch, Lawrence or Official Notice above explicitly disclose transmitting, to a transaction processor, transaction variables for the transaction, the transaction variables including a passenger name on the airline ticket, a travel date, a routing type of the airline ticket, and an electronic ticket indicator; and receiving, from the transaction processor, one of an approval of the transaction, a declination of the transaction and a request to contact a financial institution maintaining the financial account, based on the transaction variables. However, the ordinary practitioner of the art would have seen it as obvious that these transaction variables are necessary details in the transaction of claim 1. Therefore, the ordinary practitioner of the art at the time of Applicant's invention would have seen it as obvious to have combined the disclosures of Basch, Lawrence, Official Notice and the practitioner's own knowledge in order to produce a method for authorizing a financial transaction between a merchant and an account holder of a financial account, motivated by a desire to provide methods and systems which will utilize information to assist with risk management and due diligence related to travel arrangements (Lawrence, page 1, [0006]).



**Re. Claim 24**, the disclosures of Basch, Lawrence and Official Notice are stated in the rejection of claims 1 and 16 above. None of Basch, Lawrence or Official Notice above explicitly disclose determining, based on historical data, a risk value for transaction variables of transactions involving purchases of airline tickets, the transaction variables including at least one of: an account holder name, a reservation code, a passenger name, an origin city, a destination city, a travel date, a routing description, a class of service, an electronic ticket indicator, a number of passengers traveling and a carrier code; combining the risk values to generate a fraud-risk model that determines risk factors for transactions involving purchases of airline ticket; receiving a request from a merchant to authorize a transaction involving a purchase 'of a ticket by an account holder, the request including transaction variables corresponding to the account holder and the ticket; determining a risk factor for the transaction by inputting the transaction variables corresponding to the account holder and the ticket to the fraud-risk model; and generating an authorization decision for the request based on the risk factor for the transaction. However, the ordinary practitioner of the art would have seen it as obvious that these transaction variables are necessary details in the transaction of claim 1. Therefore, the ordinary practitioner of the art at the time of Applicant's invention would have seen it as obvious to have combined the disclosures of Basch, Lawrence, Official Notice and the practitioner's own knowledge in order to produce a method for authorizing a financial transaction between a merchant and an account holder of a financial account, motivated by a desire to provide methods and systems which will utilize information to assist with risk management and due diligence related to travel arrangements (Lawrence, page 1, [0006]).

**Re. Claim 25**, the disclosures of Basch, Lawrence and Official Notice are stated in the rejection of claims 1, 16 and 24 above. None of Basch, Lawrence or Official Notice above explicitly disclose receiving, from the merchant for use in real-time authorization, transaction variables for a transaction involving a purchase of a travel ticket using the financial account, the transaction variables including at least one of: a passenger name on the travel ticket, a travel date,/t routing description of the travel ticket, and an electronic ticket indicator; and processing the transaction variables through a fraud-risk

model to determine a risk factor for the transaction. However, the ordinary practitioner of the art would have seen it as obvious that these transaction variables are necessary details in the transaction of claim 1. Therefore, the ordinary practitioner of the art at the time of Applicant's invention would have seen it as obvious to have combined the disclosures of Basch, Lawrence, Official Notice and the practitioner's own knowledge in order to produce a method for authorizing a financial transaction between a merchant and an account holder of a financial account, motivated by a desire to provide methods and systems which will utilize information to assist with risk management and due diligence related to travel arrangements (Lawrence, page 1, [0006]).

**Re. dependent claims 2-15 and 17-23**, none of Basch, Lawrence or Official Notice above explicitly disclose limitations of claims 2-15 and 17-23. However, the examiner takes Official Notice that the limitations of claims 2-15 and 17-23 were well known at the time of Applicant's invention. Therefore, the ordinary practitioner of the art at the time of Applicant's invention would have seen it as obvious to have combined the disclosures of Basch, Lawrence, Official Notice and the practitioner's own knowledge in order to produce a method for authorizing a financial transaction between a merchant and an account holder of a financial account, motivated by a desire to provide methods and systems which will utilize information to assist with risk management and due diligence related to travel arrangements (Lawrence, page 1, [0006]).

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is 571-272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Charles Kyle, can be reached on 571-272-6746.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). The following is a LINK to PRIVATE PAIR - <https://portal.uspto.gov/authenticate/AuthenticateUserLocalEPF.html>.

Any response to this action should be mailed to:

*Commissioner of Patents and Trademarks Washington D.C. 20231*  
or faxed to:

(571)273-8300 [Official communications; including After Final communications  
labeled "Box AF"]

or

(571) 273-6792 [Informal/Draft communications, labeled "PROPOSED" or  
"DRAFT"]

Hand delivered responses should be brought to the address found on the above USPTO web site in Alexandria, VA.

SEC

Art Unit 3695

June 22, 2009

/Narayanswamy Subramanian/

Primary Examiner, Art Unit 3695